

U.S. Patent Application Serial No. **10/019,287**
Amendment filed May 25, 2006
Reply to OA dated March 1, 2006

REMARKS

Claims 6-11, 19-30 and 34-88 are pending in this application. No amendment is made in this Response. It is believed that this Response is fully responsive to the Office Action dated **March 1, 2006**.

Claims 6-8, 10-11, 19-26, 28-30, 34-39, 41-51, 53-59, 61-71, 73-81, and 83-88 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a sulfur-free catalyst, such as tetra(C₃-C₈ alkyl)titanate, titanium oxide, titanium hydroxide, sodium alkoxide of 1 to 4 carbon atoms, sodium hydroxide, C₃-C₁₂ fatty acid tin salt, tin oxide, tin hydroxide, zinc oxide, zinc hydroxide, lead oxide, lead hydroxide, aluminum oxide and aluminum hydroxide, does not reasonably provide enablement for all the sulfur-free and phosphorous-free catalyst in the field of the organic and inorganic chemistry. (Office action p. 3)

The rejection of claims 6-8, 10-11, 19-26, 28-30, 34-39, 41-51, 53-59, 61-71, 73-81, and 83-88 under 35 U.S.C. 112, first paragraph, is respectfully traversed.

In the rejection, the Examiner states that “the instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation,” with reference to *In re Wands*. The Examiner refers to the catalysts in the claim, stating that the specification provides only three exemplified catalysts, and states that “the catalyst compositions represent an unpredictable aspect in the art of organic chemistry.”

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In response, Applicant argues that **no experimentation** is necessary to practice the invention as claimed. The catalysts for performing the claimed reactions are **well defined** in the specification, and **one of skill in the art could use those catalysts to carry out the invention**. The fact that a limited number of catalysts are used in the working examples of the specification is irrelevant. The issue in the cited *In re Sizto*, dealing with support for non-enzyme catalysts only provided by one example of an enzyme catalyst, is not clearly relevant to the present application, where the specification clearly defines the catalysts, and where the “absence of a catalyst” is also recited.

The Examiner's argument about an “unpredictable aspect,” as understood by the Applicant, appears to be a statement that some of the possible catalysts may not perform as well as some other catalysts. This may be the case, but this appears to be only a statement that some modes of the invention may not be as good as other modes, which is true for almost any invention. One of skill in the art could carry out the process of the claims as recited. If the reaction is carried out using the recited “sulfur-free and phosphorus-free catalyst” in the preparation of an ester, the adjustment of reaction conditions would be common practice to persons skilled in the art, and would not even be considered “experimentation,” much less “undue experimentation.”

Reconsideration of the rejection is respectfully requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, the applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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